



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,206	12/26/2001	Scott M. Frank	190254-1070	2850

38823 7590 12/23/2005

THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP/  
BELLSOUTH I.P. CORP  
100 GALLERIA PARKWAY  
SUITE 1750  
ATLANTA, GA 30339

EXAMINER

APPIAH, CHARLES NANA

ART UNIT	PAPER NUMBER
----------	--------------

2686

DATE MAILED: 12/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/036,206

Applicant(s)

FRANK ET AL.

Examiner

Charles N. Appiah

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 8-10, 14-19 and 41-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 41-44 is/are allowed.
- 6) ☒ Claim(s) 8-10 and 14-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/06/05, 10/06/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on October 03, 2005 has been entered.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on October 03, 2005 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner and made of record appropriately.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8, 9, 12, 15, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Fernandes et al. (GB 2 285 556) in view of Torrey et al. (6,466,799).**

Regarding claim 8, Fernandes discloses a method for providing telephone services in a mobile telecommunications network comprising a home base station (PBS 10), at least one mobile telephone (MS 12), and at least one telephone device (18, 14), (see Figs. 1 and 3), the method comprising: registering the at least one mobile telephone with the home base station by storing information identifying the at least one mobile telephone (step 36, mobile registering with PBS using location update procedure, see page 5, lines 21-26, page 8, lines 27-29), detecting by the home base station the presence of the at least one mobile telephone (mobile being a preferred mobile by PBS and PBS accepting mobile, steps 38-40), establishing communication between the at least one telephone device and the home base station (feature of establishing link by an auto dialing action of the personal base station into a wireline network, page 6, lines 3-11), establishing communication between the at least one mobile telephone and the home base station (step 40-42, mobile entering idle mode and waiting for outgoing or incoming call procedure), and transmitting the information identifying the at least one mobile telephone to at least one telephone device (inherent feature of auto dialing action of the personal base station into a wireline network, leading to end to end connectivity on a speech channel establishment, col. 6, lines 3-11). Fernandes fails to explicitly teach detecting the at least telephone device being off-hook, receiving a dialed telephone number and sending the dialed number to the at least mobile telephone.

In an analogous field of endeavor, Torrey discloses an apparatus for allowing a consumer to place wireless calls over their handheld wireless communications

devices from telephones connected throughout their location while keeping the convenience and flexibility of a hand-held communications device while allowing simultaneous calls to be placed over wireless and telephone network using different connected standard telephone devices (see col. 2, lines 13-59). According to Torrey, (see Fig. 4A), a premises station system includes feature of detecting a telephone device being off-hook (step 405), receiving a dialed number (steps 408,410) and sending the dialed telephone number to the at least one mobile telephone (steps 415, 420, 430, 435, 440 and 445, col. 6, lines 16-54).

It would therefore have been obvious to one of ordinary skill in the art to combine Torrey's simultaneous capability of placing calls over wireless and telephone networks with Fernandes' system in order to provide the convenience, flexibility, mobility and personal security, especially in an emergency situation when only one of the networks is accessible as taught by Torrey.

Regarding claim 9, Fernandes further discloses (see Fig. 3): receiving identification information from the at least one mobile telephone (step 36), comparing the identification information received with the information stored (step 38), and if the identification information received matches the information stored, sending a request to establish communication with the at least one mobile telephone (Yes from step 38 to step 40).

Regarding claim 12, Fernandes further discloses receiving a signal from the at least one mobile telephone, the signal indicating an incoming call, ringing the at least one telephone device connected to the home base station and detecting the at least

one telephone device answering (call arrival "ringing" state of a public network being recognized, page 6, lines 12-20) and sending a message to the at least one mobile telephone, the message indicating that the at least one telephone device answered the incoming call (see page 6, lines 15-20).

Regarding claim 15, the combination of Fernandes and Torrey further teach determining if at least one telephone device is available for answering the incoming call (see steps 450-490, Fig. 4B of Torrey).

Regarding claim 17, the combination of Fernandes and Torrey further discloses as taught by Torrey providing dial tones to the at least one telephone device (see generation of dial tone, step 408, Fig. 4A of Torrey).

Regarding claim 19, Fernandes as modified by Torrey further discloses wherein the at least one telephone device is a corded telephone device. (see Figs. 1A, 2A of Torrey).

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Fernandes et al** and **Torrey et al** as applied to claim 8 above, and further in view of well known prior art Official Notice.

Regarding claim 10, Fernandes as modified by Torrey fail to explicitly teach displaying on the home base station the identification information of the at least one mobile telephone.

The concept of displaying caller identification information on a mobile terminal is very well known in the art and as such examiner takes Official Notice that it would have been obvious to one of ordinary skill in the art to provide for the display of any

desired communication information including identification information on Fernandes as modified by Torrey in order to ensure the appropriate routing of incoming calls where there are a plurality of mobile devices.

6. Claim 18 is rejected under 35 U.S.C. 103(a) as being obvious over **Fernandes et al** and **Torrey et al** as applied to claim 8 above and further in view of **Reed et al. (5,574,984)**.

Regarding claim 18, Fernandes as modified by Torrey fail to teach detecting by the home base station the strength of radio signals from the at least one mobile telephone is fading and if a call is established, terminating the call.

Reed discloses a method and apparatus for controlling a power level of a base station in which a fading characteristic of signals received from a mobile station is detected and compared to a threshold and the result used to make call termination decisions (see Fig. 1, col. 3, lines 30-40, col. 4, lines 1-15).

It would therefore have been obvious to one of ordinary skill in the art to provide for the detecting of signal strength and fading characteristic to the system of Fernandes and Torrey in order to ensure provision of good quality communications to subscribers by terminating bad quality communication connections.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

Art Unit: 2686

from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claim 8 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 11,048,132. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations of the '132 application are broad enough to be encompassed by the limitations of claim 8 of the instant application and as such it would have been obvious to one of ordinary skill in the art to implement the system of the '132 application using the method steps of the instant application .

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claims 14 and 16 are provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 11/048,132, and further in view of **Bhatia et al. (WO 01/58181)**.



Regarding claims 14 and 16, claim 1 of the '132 application fails to disclose wherein the home base station and the cordless and/or mobile telephone device follows Bluetooth protocols.

Bhatia discloses a system and method for connecting external devices wirelessly to a base transceiver station (BTS) via a short-range ad-hoc network such as the Bluetooth network (see abstract, Figs. 1-3). According to Bhatia, the BTS has a Bluetooth compatible transceiver for interfacing with the external equipment and also a Bluetooth adapter which is responsible for determining the address of each Bluetooth capable external equipment connected to the BTS and the type of equipment (protocol) it is (see page 5, lines 3-20).

It would therefore have been obvious to one of ordinary skill to combine the teaching of Bhatia by providing the use of Bluetooth protocols for wireless connection between a base station and external equipment with claim 1 of the '132 application in order to provide short range communications with ease of installation and reduced cost as taught by Bhatia.

This is a provisional obviousness-type double patenting rejection.

7. Claims 13, 15, and 17, are provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 11/048,132, and further in view of **Haartsen (5,771,453)**.

Regarding claims 13 and 15 claim 1 of the '132 application meets all limitations as applied above to claim 8 above. Claim 1 of the '132 application fails to teach determining if at least one telephone device is available for answering the incoming call.

Haartsen discloses a personal base station, which allows the wire network to be accessed by multiple cellular terminals within the local region of the base station (see col. 2, lines 1-18), including receiving a signal from the at least one mobile telephone, the signal indicating an incoming call, ringing the at least one telephone device connected to the home base station, detecting the at least one telephone device answering the incoming call (see col. 7, lines 31-42), and sending a message to the at least one mobile telephone device answering the incoming call (see col. 2, line 61 to col. 3, line 17 and col. 11, lines 7-17). Haartsen further discloses wherein the at least one telephone device is a cordless telephone (terminal 120a is cordless, see Fig. 1).

It would therefore have been obvious to one of ordinary skill in the art to combine the teaching of the '132 application system of claim 1 in order to provide the benefits of low cost and mobility which can be used in both a personal, cordless and cellular environment.

Regarding claim 17, the combination of claim 1 of the '132 application inherently discloses providing dial tones to the at least one telephone device and receiving a dialed number from the at least one telephone device (see Haartsen, col. 10, line 46 to col. 11, line 5). It is inherent that the attached terminal originating a call and for which a connection is made to the base station, is allowed to make a call using a dialed number when the remaining terminals are prevented from accessing the base station.

This is a provisional obviousness-type double patenting rejection

***Allowable Subject Matter***

10. Claims 41-44 are allowed.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rosen et al. (6,470,187) discloses a multi-base station cordless telephone system.

Bursztejn et al. (6,459,688) discloses a method of registering a dual-mode mobile station with an associated private base station.


Dent (6,529,707) discloses a satellite communications adapter for dual mode communications.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles N. Appiah whose telephone number is 571 272-7904. The examiner can normally be reached on M-F 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 571 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CA

  
**CHARLES APPIAH**  
**PRIMARY EXAMINER**